

**REMARKS**

Claims 1 and 3-48 are pending in the present application. Claims 1, 18, 25, 37, and 45 have been amended. No new matter has been added.

Claims 1 and 3-36 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1 and 3-17 are rejected under 35 U.S.C. § 101 because the subject matter is directed to non-statutory subject matter. Claims 1, 3-35, 37-42, and 44-48 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Carlisle (U.S. Patent No. 5,649,118), in view of Derksen (U.S. Patent No. 5,478,993) and Gungl (U.S. Patent No. 5,912,453), and in further view of O'Mahony (Electronic Payment Systems, 1997, ISBN 0-89006-925,5, pp. 208-12). Claims 36 and 43 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Carlisle, in view of Derksen and Gungl, in further view of O'Mahony, and further in view of Taskett (U.S. Patent No. 5,991,748).

**Rejection of Claims 1 and 3-36 under 35 U.S.C. § 112**

Claims 1 and 3-36 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This rejection is respectfully traversed.

In particular, the Examiner states claims 1 and 3-17 recite in the preamble “a system for performing a financial transaction...” and the body of the claims does not contain any limitations indicating the structure of the system. “Applicant’s claimed limitations consist of electronic applications (software according to the specification) that do not describe the structure of the system.” Accordingly, claim 1 has been amended to recite a processor for executing the applications. Exemplary support for this amendment can be found in the specification on page 8 and Figures 1 and 2.

The Examiner further indicates that claims 1 and 3-36 recite in the preamble a system, a smart card and method for performing a financial transaction and there is no indication anywhere in the body of the claims of a transaction being performed or taking place. Accordingly, claim 1 has been amended to recite “a transaction card configured for performing the financial transaction,” claim 18 has been amended to recite “wherein the smart card is configured for

performing the financial transaction,” and claim 25 has been amended to recite “performing the financial transaction.”

The undersigned representative notes that the rejection of claims 1 and 3-48 under 35 U.S.C. § 112 was not sustained by the Board in the Decision on Appeal of August 18, 2008. Although the Board found the claims satisfied 35 U.S.C. § 112, the claims have been amended to expedite prosecution.

Therefore, it is respectfully requested that the rejection of claims 1 and 3-36 under 35 U.S.C. § 112, second paragraph, be withdrawn.

#### **Rejection of Claims 1 and 3-17 under 35 U.S.C. § 101**

Claims 1 and 3-17 are rejected under 35 U.S.C. § 101 because the subject matter is directed to non-statutory subject matter. This rejection is respectfully traversed.

The examiner states claims 1 and 3-17 recite in the preamble “a system for performing a financial transaction...”, “the body of the claims does not contain any limitations indicating the structure of the system”, and therefore the claims “are non-statutory because the claims are directed towards software, *per se*, lacking storage on a medium, which enables any underlying functionally to occur.” Accordingly, claim 1 has been amended to recite “a processor coupled to a memory for executing [the applications].”

Therefore, it is respectfully requested that the rejection of claims 1 and 3-17 under 35 U.S.C. § 101 be withdrawn.

#### **Rejection of Claims 1, 3-35, 37-42, and 44-48 under 35 U.S.C. § 103(a)**

Claims 1, 3-35, 37-42, and 44-48 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Carlisle in view of Derksen and Gungl and in further view of O’Mahony. This rejection is respectfully traversed.

The Examiner asserts that the terminology “accessible,” “accessible for use,” and “transferable...for use” are capable of performing specific functions, but does not mean that they actually perform the functions as recited in the claims. Accordingly, claims 1, 18, 25, 37, and 45 have been amended so that these functions are recited as positive limitations. Thus, it is believed that independent claims 1, 18, 25, 37, and 45 are allowable over the cited art. Because independent claims 1, 18, 25, 37, and 45 are believed to be allowable, the undersigned

representative submits that dependent claims 3-17, 19-24, 26-35, 38-42, 44, and 46-48 are also allowable.

Therefore, it is respectfully requested that the rejection of claims 1, 3-35, 37-42, and 44-48 be withdrawn.

**Rejection of Claims 36 and 43 under 35 U.S.C. § 103(a)**

Claims 36 and 43 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Carlisle, in view of Derksen and Gungl, in further view of O'Mahony, and further in view of Taskett. This rejection is respectfully traversed. As discussed above, it is believed that independent claims 25 and 37 are allowable over the cited art. Because independent claims 25 and 37 are believed to be allowable, the undersigned representative submits that dependent claims 36 and 43 are also allowable. Therefore, it is respectfully requested that the rejection of claims 36 and 43 be withdrawn.

**CONCLUSION**

The undersigned representative respectfully submits that this application is in condition for allowance, and such disposition is earnestly solicited. If the Examiner believes that the prosecution might be advanced by discussing the application with the undersigned representative, in person or over the telephone, we welcome the opportunity to do so. In addition, if any additional fees are required in connection with the filing of this response, the Commissioner is hereby authorized to charge the same to Deposit Account No. 504402.

Respectfully submitted,

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